

REMARKS

The Office Action rejects claims 65-74 under 35 U.S.C. § 112, second paragraph, as being indefinite. Office Action at 3. The Office Action also rejects claims 38-43, 45, 48, 53-56, 58, and 61-63 under 35 U.S.C. § 102(b) as being anticipated by "German 624 (DE 3901624)." Id. at 3. Additionally, the Office Action rejects claims 38-58, 61, and 64-74 under 35 U.S.C. § 103(a) as being unpatentable over "Haas (US 4,606,389)," "Japan 215 (JP 183215)," "Japan 907 (JP 63-116907)," and German 624. Id. at 5. The Office Action also rejects claims 45-47, 58-60, and 62-63 under 35 U.S.C. § 103(a) as being unpatentable over the preceding references "and further in view of Nakagawa et al. (US 6220320) or Japan 307 (JP 63-315307)." Id. at 6.

By this Reply, Applicant has amended the claims to replace each recitation of "tire" with a recitation of "motorcycle tire." Additionally, Applicant has amended claim 38 to recite "wherein the rear motorcycle tire has a curvature ratio lower than the front motorcycle tire." Applicant has also amended claim 65 to recite "providing a central zone of the tread band of the front motorcycle tire with a sea/land ratio greater than or equal to about 15% to enhance water-draining capacity of the front motorcycle tire under a ground contacting area within a central zone of the tread band of the front motorcycle tire; and providing a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire to enhance traction capacity of the rear motorcycle tire." Further, Applicant has amended claim 67 to be consistent with the amendments to claim 65. Additionally, Applicant has added new claim 75, which recites "[t]he pair of motorcycle tires of claim 38, wherein the tread band of the rear motorcycle tire further comprises: axially opposite shoulder zones of the tread band of the rear

motorcycle tire external to the central zone of the tread band of the rear motorcycle tire; and axially opposite intermediate side zones lying between the central zone and the shoulder zones, wherein each of the intermediate side zones has a sea/land ratio greater than or equal to about 15%.” Applicant has cancelled claim 52. Applicant respectfully submits that the originally filed application and drawings fully support the claim amendments. No new matter has been added. Claims 38-51 and 53-75 are currently pending in this application.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Regarding the rejections of claims 65-74 under 35 U.S.C. § 112, second paragraph, Applicant respectfully submits that the Amendments to claim 65 should address the Examiner’s concerns expressed in the Office Action. While Applicant respectfully submits that the previous wording of claims 65-74 fully complied with the requirements of Section 112, Applicant respectfully submits that the amendments to claim 65 should remove the Examiner’s concerns about “the scope and meaning” of these claims. See Office Action at 2. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 65-74 under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 102(b)

Regarding the rejections of claims 38-43, 45, 48, 53-56, 58, and 61-63 under 35 U.S.C. § 102(b), Applicant respectfully submits that German 624 cannot anticipate these claims. Each of claims 38-43, 45, 48, 53-56, 58, and 61-63 is directed to “[a] pair of pneumatic motorcycle tires, comprising: a front motorcycle tire; and a rear motorcycle tire; . . . wherein the rear motorcycle tire has a curvature ratio lower than the front motorcycle tire” (emphasis added). Applicant respectfully submits that German 624

does not teach or suggest any of these claim features. German 624 discloses tires for four-wheeled vehicles, not motorcycle tires, and German 624 fails to teach or suggest that a "rear motorcycle tire has a curvature ratio lower than the front motorcycle tire."

See Translation of German 624 at ¶ [0001]. Thus, German 624 cannot anticipate claims 38-43, 45, 48, 53-56, 58, and 61-63. Accordingly, Applicant respectfully requests withdrawal of the rejection of these claims under 35 U.S.C. § 102(b).

Rejections Under 35 U.S.C. § 103(a)

Regarding the rejections of claims 38-51 and 53-64 under U.S.C. § 103(a), Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness. A proper obviousness rejection must address every claim feature.

See M.P.E.P. § 2143.03. To establish a *prima facie* case of obviousness, the Office Action must provide a clear explanation with rational underpinnings that demonstrates why a person of ordinary skill in the art would have found the claimed subject matter obvious. M.P.E.P. § 2142.

Furthermore, the Examiner must not succumb to hindsight and use Applicant's disclosure "as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of [Applicants' claimed invention]." Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907 (Fed. Cir. 1988), citing Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012 (Fed. Cir. 1983). In the instant case, Applicants respectfully submit that the Office Action takes exactly this prohibited approach of using Applicants' disclosure as a recipe for making modification after modification to prior art disclosures, in attempt to arrive at Applicant's claimed invention. Indeed, the Office Action heaps as many as six

references upon one another, discriminately selecting from each only those portions that help the Office Action reproduce Applicant's invention after the fact.

Yet, even with all these references, the Office Action fails to muster viable support for its assertions of obviousness of "[a] pair of pneumatic motorcycle tires, comprising: a front motorcycle tire; and a rear motorcycle tire; . . . wherein the tread band of the front motorcycle tire comprise at least one circumferential groove; and . . . wherein the at least one circumferential groove extends at an equatorial plane of the front motorcycle tire within a central zone of the tread band of the front motorcycle tire; wherein the tread band of the rear motorcycle tire comprises: an area defining a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire," as recited in claim 38. The Office Action attempts to rely on Japan 907 to establish that a person of ordinary skill in the art would have found it obvious to use a rear motorcycle tire having "a substantially null sea/land ratio within a central zone of the tread band" in combination with a front motorcycle tire having "at least one circumferential groove . . . within a central zone of the tread band."

In reality, Japan 907 directly contradicts the position of the Office Action by suggesting that the front and rear motorcycle tires of any given pair should both either include or omit "at least one circumferential groove . . . within a central zone of the tread band." Japan 907 discloses a number of pairs of front and rear motorcycle tires, in each of which the center portion of the treadband of the front and rear tires has the same configuration. See Figs. 1(a) and 1(b); Figs. 2(a) and 2(b); and Figs. 3(a) and 3(b). Thus, Japan 907 would actually suggest to a person of ordinary skill in the art not to

compose a pair of front and rear motorcycle tires with tires having different configurations in a central zone of the tread band.

The Office Action also discusses German 624, but concedes that this reference would not suggest to a person of ordinary skill in the art to employ a motorcycle tire "with a tread central region having a null sea/land area." Office Action at 5. Indeed, German 624 not only fails to suggest using such a rear motorcycle tire, it fails to remotely discuss any aspect of the design of motorcycle tires, discussing only tires for four-wheeled vehicles. See Translation of German 624. Accordingly, with the knowledge that the demands on and design considerations for motorcycle tires differ markedly from those associated with four-wheeled vehicles, a person of ordinary skill in the art would not even look to German 624 for guidance in the field of motorcycle tires. Such non-analogous art cannot support a *prima facie* case of obviousness. See M.P.E.P. § 2141.01(a).

Thus, German 624 and Japan 907 fail to suggest using a rear motorcycle tire having "an area defining a substantially null sea/land ratio within a central zone of the tread band" paired with a front motorcycle tire having "at least one circumferential groove . . . within a central zone of the tread band of the front motorcycle tire." Haas, Japan 215, Nakagawa, and Japan 307 fail to cure this deficiency. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 38-51 and 53-64 under U.S.C. § 103(a).

Regarding the rejections of claims 65-74 under 35 U.S.C. § 103(a), Applicant respectfully submits that the Office Action also fails to establish a *prima facie* case of obviousness of these claims. A method according to any of claims 65-74 includes, *inter*

alia, "providing a central zone of the tread band of the front motorcycle tire with a sea/land ratio greater than or equal to about 15% . . . ; and providing a substantially null sea/land ratio within a central zone of the tread band of the rear motorcycle tire."

Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness of these claim features for at least substantially the same reasons it fails to establish a *prima facie* case of obviousness of claims 65-74. Accordingly, Applicant respectfully requests withdrawal of the rejections of these claims under 35 U.S.C. § 103(a).

New Claim 75

Regarding new claim 75, Applicant respectfully submits that this claim is novel and non-obvious over the cited references for at least the above-discussed reasons that claims 38-51 and 53-74 are non-obvious over the cited references. Additionally, new claim 75 recites that "the tread band of the rear motorcycle tire further comprises: axially opposite shoulder zones of the tread band of the rear motorcycle tire external to the central zone of the tread band of the rear motorcycle tire; and axially opposite intermediate side zones lying between the central zone and the shoulder zones, wherein each of the intermediate side zones has a sea/land ratio greater than or equal to about 15%" (emphasis added). Applicant respectfully submits that none of the cited references teach or even suggest these claim features. Indeed, in rejecting claim 54, the Office Action fails to even allege that any of the cited references meet the claimed feature that "each of the intermediate side zones has a sea/land ratio greater than or equal to about 10% and less than or equal to about 30%." See Office Action at 6. Accordingly, Applicants respectfully request examination and allowance of new 75.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicants' undersigned agent at 202-408-4492.

Respectfully submitted,

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By:


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